

## **Remarks**

Responsive to the Office Action mailed November 6, 2006, Applicant provides the remarks herein. Reexamination and allowance of the subject application are respectfully requested.

Applicant also appreciates the Examiner's remarks noting that claims 69-71 are allowable.

### ***Claim Amendments***

Independent claims 55 and 62 have been amended to recite that at least a portion of the protrusion is configured to extend over at least a portion an un-excised articular surface proximate the implant. Support for this amendment may be found, for example, in paragraph [0231] of the published application which literally states that the protrusion is provided to cover at least a portion of an un-excised portion of the articular surface as well as FIG. 62b.

Claim 59 has been amended to be consistent with independent claim 55.

Independent claim 65 has been amended to recite that the implant includes an outer perimeter generally disposed about the distal and the proximal surfaces comprising at least two surfaces each having a concentric arcuate shape with a common center and a first and at least a second generally opposing side surfaces extending generally along a length of the implant between the at least two arcuate shaped surfaces. Support for this amendment may be found, for example, in paragraph [0241] of the published application which states, *inter alia*, "[t]he implant 6500 has a least two side surfaces 6517, 6519 each having a concentric arcuate shape with a common center", in paragraph [0244] which states, *inter alia*, "[t]he implant also may also have two other opposing side surfaces 6521, 6523. Such surfaces 6521, 6523 are generally flat to where the surface cutter "runs off" of the condyle", as well as FIGS. 65-67.

Claim 67 has been cancelled without prejudice.

Accordingly, claims 55-66 and 68-71 are pending. Applicant submits that no new matter has been added.

### ***Double Patenting***

Claims 55-71 were rejected on the grounds of non-statutory obviousness-type double patenting over claims 1-66 of US Patent No. 6,679,917 and over claims 1-13 of US Patent No. 6,520,964. Enclosed is a Terminal Disclaimer to obviate the double patenting rejection of claims 55-71 over claims 1-66 of US Patent No. 6,679,917 and over claims 1-13 of US Patent No. 6,520,964. Therefore, no further discussion of the Double Patenting rejection is believed necessary. Also enclosed is a credit card authorization to charge the Terminal Disclaimer fee. In the event there are any additional fees due not otherwise provided for herein, please charge them to Deposit Account 50-2121.

### ***Rejections Under 35 USC §102***

Claims 55-68 were rejected under 35 U.S.C. § 102(e) as being anticipated by Schwartz et al. (U.S. Patent No. 6,251,143, hereinafter referred to as "Schwartz"). Applicant respectfully traverses this rejection.

#### **A. Rejection of Claims 55-64 Under 35 U.S.C. § 102**

Independent claims 55 and 62 have been amended to recite that at least a portion of the protrusion is configured to extend over at least a portion an un-excised articular surface proximate the implant. Applicant respectfully submits that Schwartz does not disclose or suggest these limitations and respectfully requests reconsideration in view of the above amendments.

The present Office Action refers to column 3, lines 49-59 and FIGS. 8 and 10 of Schwartz as teaching a protrusion configured to extend over at least a portion of an un-excised surface proximate the implant as recited in amended independent claims 55 and 62. After a careful review of these passages of Schwartz, however, Applicant respectfully submits that Schwartz does not teach or suggest all of the features of amended independent claims 55 and 62.

In particular, FIG. 8 of Schwartz referred to in the present Office Action is directed towards an implant 10B having “a perforated and preferably porous film 22B, a delivery unit 14B (including an elongate member 26B and three radial arms 28B) and a pair of inserts 16B (perforated therethrough by several relatively small holes).” *See column 12, lines 60-65.*

FIG. 10 of Schwartz referred to in the present Office Action is directed towards an implant 10C “which dispenses entirely with the need for either a porous film or wrap 22 or a retainer 20.” *See column 13, lines 15-17.*

Column 3, lines 49-59 of Schwartz referred to in the present Office Action is directed towards an implant having an aperture through the central body, a retainer means, and a porous film.

Applicant respectfully submits that none of the passages referred to in the present Office Action disclose or suggest a protrusion configured to extend over at least a portion of an un-excised surface proximate the implant as recited in amended independent claims 55 and 62. Moreover, Applicant respectfully submits that the remaining portions of Schwartz do not disclose or suggest an implant having a protrusion configured to extend over at least a portion of an un-excised surface proximate the implant as recited in amended independent claims 55 and 62. Accordingly, Applicant respectfully submits that Schwartz does not disclose or suggest all of the limitations recited in amended independent claim 55 and 62.

Claims 56-61 and 63-64 depend, either directly or indirectly, from independent claims 55 and 62, respectively. Therefore, Applicant respectfully submits that claims 56-61 and 63-64 are also allowable by virtue of their dependency from independent claims 55 and 62, respectively, in addition to their own patentable limitations.

#### **B. Rejection of Claims 65-68 Under 35 U.S.C. § 102**

Claim 67 has been cancelled without prejudice. Accordingly, the rejection of claim 67 is now moot.

Independent claim 65 has been amended to recite that the implant includes an outer perimeter generally disposed about the distal and the proximal surfaces comprising at least two surfaces each having a concentric arcuate shape with a common center and a first and at least a second generally opposing side surfaces extending generally along a length of the implant between the at least two arcuate shaped surfaces. Applicant respectfully submits that Schwartz does not disclose or suggest these limitations and respectfully requests reconsideration in view of the above amendment.

The present Office Action refers to FIGS. 29-35 of Schwartz as teaching an implant having a truncated circular shape. As can be seen in FIGS. 29-35 of Schwartz, the implants 10L have a generally figure "8" shape comprising two overlapping circles generally centered around two delivery units 14L and 14L'. *See also, column 17, line 50-column 18, line 10.* The two circles of implant 10L are not centered about a common center as recited in amended independent claim 65, but rather the two circles of implant 10L are centered about a first and a second, different center (i.e., the two delivery units 14L and 14L'). Accordingly, Applicant respectfully submits that Schwartz does not disclose an implant having a concentric arcuate shape *with a common center* as recited in amended independent claim 65.

Claims 66 and 68 depend directly from independent claim 65. Therefore, Applicant respectfully submits that claims 66 68 are also allowable by virtue of their dependency from independent claim 65 in addition to their own patentable limitations.

In view of the foregoing, Applicant respectfully submits that the pending claims are believed to be patentable over Schwartz et al.

Having dealt with all of the issues raised by the Examiner, it is respectfully submitted that the present application, as amended, is in condition for allowance. Thus, early allowance is earnestly solicited.

In the event of any fee deficiencies, or that additional fees are payable, please charge our Deposit Account No. 50-2121 as necessary.

Respectfully submitted,

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